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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/073,160	02/13/2002	Hartmut Strobel	04734-0003	4730

7590 05/09/2003  
Finnegan, Henderson, Farabow,  
Garrett & Dunner, L.L.P.  
1300 I Street, N.W.  
Washington, DC 20005-3315

EXAMINER

SAEED, KAMAL A

ART UNIT	PAPER NUMBER
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1626

DATE MAILED: 05/09/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Applicant(s)

10/073,160

Applicant(s)

STROBEL ET AL.

Examiner

Kamal A Saeed

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 23 April 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) 7-20 and 23 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☒ Claim(s) 1-6, 21 and 22 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

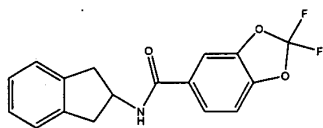
- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3. 6) ☐ Other:

### DETAILED ACTION

Claims 1 – 23 are pending in this application. Claims 7- 20 and 23 are withdrawn from further consideration by the Examiner, 37 C.F.R. § 1.142(b), as being drawn to a non-elected invention. The withdrawn subject matter is patentably distinct from the elected subject matter as it differs in structure and element and would require separate search considerations. In addition, a reference which anticipates one group would not render obvious the other.

#### *Response to Restriction*

Applicant's election with traverse of Group I, claims 1-6, 21 and 22, drawn to compounds of Formula I, depicted in claim 1, and the species, of Example 66,



, 2,2-Difluoro-benzo[1,3]dioxole-5-carboxylic acid indan-2-ylamide, disclosed

on page 18 of the specification, is acknowledged. The traversal is on the ground(s) that each of the elected Group could be extended to other groups without imposing an undue burden on the Examiner. This is not found persuasive because each of the various Groups is directed to art recognized compounds which are different from each other and, are capable of supporting their own patents. As the substituents change, the classes and subclasses change and the examiner is required to conduct a commercial data base search on each class and subclass. This would be an undue burden on the examiner.

Additionally, the 35 U.S.C. 121, statutory patent law, is the singular basis for the restriction. The 35 U.S.C. 121 makes clear that restriction may be required in certain applications and that the Director/Commissioner has the right to make such a determination.

Therefore, the restriction requirement in paper No. 8 is still deemed proper and is made FINAL.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Applicants preserve their right to file a divisional on the non-elected subject matter.

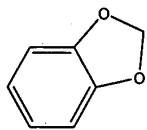
#### *Status of the Claims*

Claims 1-23 are pending in this application. The generic concept of the elected subject matter of claims 1-6, 21 and 22 is as follows:

Compound of the structure depicted in, of claim 1, wherein

**A** and **B**, independently represent CH<sub>2</sub>, CHOH or CH-(C<sub>1</sub>-C<sub>3</sub>-alkyl);

**R**<sup>1</sup> and **R**<sup>4</sup>, independently represent from the group consisting of H, optionally substituted C<sub>1</sub>-C<sub>10</sub>-alkyl, C<sub>2</sub>-C<sub>10</sub>-alkenyl or C<sub>2</sub>-C<sub>10</sub>-alkynyl, the substituents of which are as defined **except** that they don't include a **heteroaryl group**; **R**<sup>2</sup> and **R**<sup>3</sup>, independently represent from the group consisting of H, halogens, optionally substituted C<sub>1</sub>-C<sub>10</sub>-alkyl, the substituents of which are as are OH or phenyl and they don't include a heteroaryl group; **R**<sup>5</sup> represents optionally substituted



*Benzo[1,3]dioxole* group; **R**<sup>6</sup> and **R**<sup>20</sup> are as defined **except** that they don't represent a

**heterocyclic group** or a group further substituted **heterocyclic group**.

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As a result of the election and the corresponding generic concept identified, the remaining subject matter of claims 1-6, 21 and 22 are withdrawn from further consideration pursuant to 37 CFR 1.142 (b) as being drawn to non-elected inventions. The withdrawn subject matter of claims 1-13 is properly restricted as it differs materially in structure and in element from the elected subject matter supra so as to be patentably distinct there from.

### ***Objections***

Claims 1-6, 21 and 22 are objected to for containing non-elected subject matter. Claims drawn solely to the elected invention as identified supra, would appear allowable. The claims must be amended to exclude non-elected subject matter. Groups II and III drawn to methods of use and process of preparing, would be allowable along with the elected invention and commensurate in scope therewith.

This objection may be overcome by limiting the claims to the elected subject matter identified supra.

### ***Telephone Inquiry***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kamal Saeed whose telephone number is (703) 308-4592. The examiner can normally be reached on Monday-Friday from 8:00 AM – 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Joseph K. McKane, can be reached at (703) 308 4537. The unofficial fax phone for this group are (703) 308-4556 or 305-3592.

When filing a FAX in Technology Center 1600, please indicate the Header (upper right)

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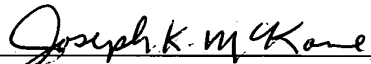
"Official" for papers that are to be entered into the file, and "Unofficial" for draft documents and other communications with the PTO that are not for entry into the file of the application.

This will expedite processing of your papers.

Communication via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by applicant and should be addressed to [joseph.mckane@uspto.gov]. All Internet e-mail communications will be made of record in the application file. PTO employees will not communicate with applicant via Internet e-mail where sensitive data will be exchanged or where there exists a possibility that sensitive data could be identified unless there is of record an express waiver of the confidentiality requirements under 35 U.S.C. 122 by the applicant. See the Interim Internet Usage Policy published by the Patent and Trademark Office Official Gazette on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist, whose telephone number is (703) 308-2286.

Kamal Saeed, Ph.D.,  
May 6, 2003

  
\_\_\_\_\_  
Joseph K. McKane  
Supervisory Patent Examiner  
Art Unit 1626, Group 1620  
Technology Center 1